

**REMARKS**

This is a response to the Office action mailed May 17, 2005 for the above-identified patent application.

The specification has been objected to for the use of the terms “novel” and “means” in the abstract and for other informalities. The abstract and the other informalities are corrected as in the above-referenced substitute specification, submitted herewith.

The drawings have been objected to for the omission of elements 72 and 74 from the appropriate figures. The drawings are amended as shown in the above-mentioned Replacement Drawing Sheet, submitted herewith.

Claims 7 and 10 have been objected to for informalities. Claim 1 stands rejected under 35 U.S.C. § 112, first and second paragraph. Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph. Claims 10 and 11 stand rejected under 35 U.S.C. § 102. Claims 2, 3, 5, 6, 9, 12 stand rejected under 35 U.S.C. § 103. Claims 5-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Claim 13 has been allowed and claims 4, 7 and 8 have been indicated as containing allowable subject matter. The objections and rejections to the claims are discussed below in generally the same order as in the Office action.

**Specification**

In the abstract, the term “novel” has been deleted and the term “means” has been amended to “an arrangement for.” In paragraph 0010, the phrase “each strut assemblies” is changed to “each strut assembly.”

The section heading “BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWINGS” is amended to “BRIEF DESCRIPTION OF THE DRAWINGS.”

In the description of the drawings, the description of FIG. 2 is amended to describe a plan view of a sulky of the present invention and the description of FIG. 3 is amended to describe an elevation view of a sulky of the present invention. All other descriptions of the drawings have been reviewed and appear to be correct.

The trademark term “Velcro,” in paragraph 0033, which is the only paragraph in which the term appears, is amended to refer initially to “hook and loop fasteners” of the type marketed under the trademark “Velcro,” and thereafter to “hook and loop fasteners.”

### **Drawings**

Applicant seeks amendment to the drawings as indicated in the Replacement Drawing Sheet to add inadvertently omitted elements 72 and 74 to FIG. 6, and inadvertently omitted element 74 to FIG. 7. Elements 72 and 74 are described in paragraphs 0044-0046.

Wheel cover hook and loop fasteners 104 and 106 are shown in FIG. 9 and described in paragraph 0033, thus meeting the requirements of 37 CFR 1.83(a).

### **Claims**

#### **Claim Objections**

Claim 7 is amended to change the word “angled” to “angle.”

In claim 12, the trademark term “Velcro” is amended to read “hook and loop fasteners.”

#### **Claim Rejections – 35 U.S.C. § 112, first paragraph**

Now turning to the claim rejections pursuant to 35 U.S.C. § 112, first paragraph, claim 1 stands rejected based on the Examiner’s contention that it contains “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.”

Claim 1 is amended to more clearly call for an adjustability connection between the strut and the arch for substantially longitudinal alignment of the wheels before welding the strut assemblies to the arch.

Accordingly, it is respectfully requested that this rejection be reconsidered and claim 1 allowed.

**Claim Rejections – 35 U.S.C. § 112, second paragraph**

Now turning to the claim rejections pursuant to 35 U.S.C. § 112, second paragraph, claims 1 and 2 stand rejected for “failing to set forth the subject matter of the invention.”

Claim 1 has been amended as discussed above.

Claim 2 is amended to provide antecedent support for “welding.” Claim 2 as amended clarifies that longitudinal alignment occurs prior to the strut assemblies being welded to the arch. Accordingly, it is requested that the rejection be reconsidered and claims 1 and 2 allowed.

**Claim Rejections – 35 U.S.C. § 102**

Turning now to the claim rejections as to anticipation under 35 U.S.C. § 102, claims 10 and 11 stand rejected as being allegedly anticipated by Gaines, et al. (U.S. Patent 3,103,369). Gaines is cited for a “wheel assembly for a sulky” having a wheel, a set of tubular spokes having a circular cross-section, a rim; and a pair of substantially planar covers.

Claim 10 is patentable over Gaines because Gaines describes a single wheel cover for covering both sides of a wheel, not a pair of wheel covers, as claimed in claim 10. Gaines does not disclose a pair of wheel covers which are mounted to the wheel, as claimed in claim 10. Rather, Gaines appears to describe a “kick guard” (col. 2, ll. 62-69) which is a “rigid unitary assemblage” (col. 3, ll. 8-9) and fixed to the sulky frame by a strap 29 (col. 3, ll. 35-41) and is mounted not to the wheel, but is sandwiched between nuts 20, 21 and the outer races of the wheel bearings 22, 23 (col. 3, ll. 10-15)

Moreover, Gaines does not describe “substantially planar wheel covers” as claimed in claim 10. The Gaines kick guard is shaped substantially like a hollow disc to fit over the wheel. Additionally, the kick guard disclosed by Gaines does not cover the spokes at the bottom of the wheel. In contrast, claim 10 requires that the pair of planar wheel covers “substantially” cover the spokes. For at least these reasons, the invention

claimed in claim 10 is patentable over Gaines. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 10 allowed.

Claim 11 depends from claim 10 and is allowable for the same reasons as claim 10, plus the additional limitation of the covers being mounted to the wheel using fasteners. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 11 allowed.

### **Claim Rejections – 35 U.S.C. § 103**

Turning now to the claim rejections as to obviousness under Section 103, claim 2 is patentable over King because King does not teach longitudinal alignment of the strut assemblies before welding of the strut assemblies to the arch, as called for in claim 2. The Examiner admits that King does not teach that the arch and the strut assemblies are positioned for substantially longitudinal alignment of the wheels before welding. *See* ¶ 13 of Office action. No other reference is cited to supply this teaching, which is found only in Applicant's disclosure. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 2 allowed.

Claim 3 stands rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Davis (U.S. Patent 4,078,829) in view of Lockwood (U.S. Patent 450,167). Davis is cited for a sulky having an arch, a pair of laterally spaced wheels mounted to the arch, a seat mounted to the arch between the wheels, a pair of rails mounted to the arch, and each rail having a distal end adapted for harnessing the horse between the rails. The Examiner admits that Davis fails to teach a rail having a proximal portion mounted to the arch and a distal portion pivotally connected to the proximal portion.

Lockwood is cited for "a sulky comprising a rail having a proximal portion and a distal portion pivotally connected to the proximal portion so that the distal portion can vertically pivot with respect to the proximal portion." However, Lockwood does not disclose a sulky or rails for a sulky, but rather to "vehicle shafts" which are made in two parts adjustable vertically on each other to be adapted to animals of different heights."

Claim 3 is patentable over Davis and Lockwood because neither Davis nor Lockwood, alone or in any proper combination, teach or suggest to one of ordinary skill

in the art the sulky as claimed in claim 3, wherein the distal portions of each rail have a distal end adapted to pivot toward and away from a horse. As noted above Lockwood specifically describes the shafts as being adjustable “vertically” to be adapted to animals of different heights (col. 1, lns. 20-21). In contrast, claim 3 calls for an invention having hinged rails that swing toward and away from a horse, e.g., for adjusting to horses of different widths.

Therefore, neither Lockwood nor Davis, alone or in any proper combination, teach or suggest to one of ordinary skill in the art Applicant’s invention as claimed in claim 3, accordingly, it is respectfully requested that the rejection be reconsidered and claim 3 allowed.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Stein in view of WO 93/19969. Stein discloses a racing sulky having angled rails but does not teach or suggest an offset. WO 93/19969 discloses an offset but does not teach or suggest a rail having a portion near the arch that is angled inwardly.

Claim 5 is patentable over Stein in view of WO/93 19969 because neither reference taken singly, or in any proper combination, teaches or suggests an offset racing sulky wherein at least one rail has a portion near the arch that is angled inwardly. The references cannot properly be combined in the absence of a clear teaching, suggestion or motivation to combine the references in a manner that would result in the claimed invention instead of any of an infinite number of possibilities. The suggestion comes only from Applicant’s disclosure which cannot be used to reject Applicant’s claims under 35 U.S.C. 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F. 2d 1561 (Fed. Cir.1987). Thus, the Examiner has not presented a prima facie case that the invention as claimed would have been obvious to one of ordinary skill in the art at the time the invention was made.

There being no prima facie case of obviousness, properly speaking, there is no burden on Applicant to overcome the rejection, nevertheless, should it be deemed relevant or necessary, there is an abundance of objective evidence of non-obviousness, namely, long-felt need, unexpected and surprising results, commercial success, and copying by others.

The Rule 132 Declaration of Thomas G. Harmer, submitted herewith, indicates *long-felt need* for the invention of claim 5, because even though WO/93 19969 (published in 1993) purported to disclose an offset racing sulky, neither it nor any other offset sulky appears to have been accepted in harness racing. Harmer Decl. ¶ 4. Similarly, Stein's angled-rail sulky, despite having been in public use since about 1998, failed to prompt anyone, until Harmer, to make the invention of claim 5.

Informed by 20-plus years of experience, Harmer declares "I knew of existing sulkies but was not satisfied with any of them, which led me to make the invention of claim 5, having a priority date of July 31, 2003, which I believe to be the first sulky to incorporate the advantage of an angled rail and an offset." Harmer Decl. ¶ 7. "The invention of claim 5 was immediately accepted and embraced by the harness racing industry." Harmer Decl. ¶ 8. Such long-felt need is evidence of non-obviousness. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 103 F.3d 1538 (Fed. Cir. 1997).

The Harmer Declaration also proves that "[t]he invention of claim 5 has achieved *unexpected and surprising results* in that the harness racing sulkies of claim 5 have won so many races by such large margins that competitors have refused to race prior art sulkies against the claimed sulkies." Harmer Decl. ¶ 9. Unexpected and surprising results may establish non-obviousness. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

The Harmer Declaration further establishes that "[t]he invention of claim 5 has achieved outstanding *commercial success* in that in the past 12 months [Harmer's] company sold more than 350 sulkies covered by the claims...[representing] more than 80% of the total market." Harmer Decl. ¶ 10. "The invention of claim 5 was immediately accepted and embraced by the harness racing industry." Harmer Decl. ¶ 8. "Sales of prior art sulkies declined sharply and have languished since I introduced the sulky of claim 5." Harmer Decl. ¶ 11. Commercial success, when linked to the features of the claimed invention, may prove non-obviousness. *Graham v. John Deere*, 383 U.S. 1, 12 (1966).

The Harmer Declaration further establishes that "[t]here are many manufacturers of harness racing sulkies" and that "several of them have copied the invention of claim 5." Harmer Decl. ¶ 12. Copying by competitors of the claimed invention is an indicator

of non-obviousness. *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 991 (Fed. Cir. 1988)

Accordingly, it is respectfully requested that the rejection be reconsidered and that claim 5 be allowed.

Claim 6 depends from claim 5 and is patentable for the same reasons as claim 5 plus the limitation of a rail portion being angled at an angle of about 15 degrees. Stein and WO 93/19969 do not teach or suggest, singly or in any proper combination, an offset racing sulky wherein one rail is angled at an angle of about 15 degrees. Accordingly, it is respectfully requested that the rejection be reconsidered and that claim 6 be allowed.

Claim 9 stands rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Gaines in view of Stein. Gaines is cited for a wheel assembly for a sulky having a wheel, “a set of tubular spokes, and a rim; and a pair of substantially planar covers mounted on opposite sides of the wheel and substantially covering the tubular spokes.” Stein is cited for a sulky having an arch, a seat mounted to the arch, and a rail on each side of the seat, and a pair of wheels.

Neither Gaines nor Stein, alone or in any proper combination, teach or suggest to one of ordinary skill in the art the sulky as claimed in amended claim 9, wherein each wheel assembly includes a wheel and a pair of substantially planar covers mounted on the wheel and substantially covering the wheel. As noted above, Gaines describes a single wheel cover for covering both sides of a wheel, not a pair of wheel covers, as claimed in claim 9. Gaines does not disclose a pair of wheel covers which are mounted to the wheel, as claimed in claim 9. Rather, Gaines appears to describe a “kick guard” (col. 2, ll. 62-69) which is a “rigid unitary assemblage” (col. 3, ll. 8-9) and fixed to the sulky frame by a strap 29 (col. 3, ll. 35-41) and is mounted not to the wheel, but is sandwiched between nuts 20, 21 and the outer races of the wheel bearings 22, 23 (col. 3, ll. 10-15).

Moreover, Gaines does not describe “substantially planar wheel covers” as claimed in claim 9. The Gaines kick guard is shaped substantially like a hollow disc to fit over the wheel. Additionally, the kick guard disclosed by Gaines does not cover the spokes at the bottom of the wheel. In contrast, claim 9 requires that the pair of planar wheel covers “substantially” cover the spokes. For at least these reasons, the invention

claimed in claim 9 is patentable over Gaines. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 9 allowed.

Claim 12 stands rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Gaines. Gaines is directed to a wheel covering for a sulky having a wheel and a pair of substantially planar covers fastened to the wheel with screw fasteners.

Claim 12 depends from claim 10 and adds the limitation, wherein the covers are mounted to the wheel using hook and loop fasteners. These references fail to teach that in the racing sulky environment, the time between races can be short, and it is beneficial to have equipment that is easily and quickly assembled. Hook and loop fasteners are therefore advantageous in the racing sulky environment because hook and loop fasteners do not require tools to attach and/or remove. Claim 12 as amended is supported in paragraphs 0030 and 0033.

Accordingly, it is respectfully requested that the rejection be reconsidered and claim 12 allowed.

#### **New Claims**

Claims 14-17 are new. Each of the new claims is submitted to more particularly point out and distinctly claim subject matter patentable over the prior art, and it is believed that no broadening of the search field should be required, however, should the Examiner feel otherwise, Applicant requests that if any one or more claims is deemed to present new issues, such claim or claims should not be entered, in order to avoid unnecessary delay. See MPEP 708.02 (VIII)(C).

Claim 14 depends from claim 5, and is directed to a portion of the second rail proximate the arch angled toward the wheel centerline.

Claim 15 depends from claim 14, and is directed to each rail including a second portion extending forwardly from the angled portion, a second angled portion extending forwardly from the second portion, wherein a stirrup is located on each second portion behind the second angled portion.

Claim 16 is a new claim depending from claim 14, wherein each of said rails comprise an inwardly angled portion proximate said arch, a generally longitudinal



stirrup-holding portion, an inwardly angled intermediate portion, a generally longitudinal guiding portion, an inwardly angled flank portion, and a generally longitudinal harnessing portion.

Claim 17 is a new claim depending from claim 16, further comprising a pair of stirrups, each one of said pair of stirrups being mounted for longitudinal adjustment along a corresponding stirrup-holding portion.

Support for the new claims can be found in the following paragraphs and related figures:

Claim 14.....paragraph 0037  
Claim 15.....paragraph 0038  
Claim 16.....paragraphs 0038-0040  
Claim 17.....paragraphs 0017 and 0039.

### **Obviousness-Type Double Patenting**

Claims 5-8 stand rejected under the judicially created doctrine of obviousness-type double patenting. A terminal disclaimer is filed along with this amendment subject to allowance of these claims.

### **Allowable claims**

Claim 4 stands objected to “as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 4 has been rewritten in the form indicated as allowable.

The Examiner indicated that claims 7 and 8 “would be allowable if rewritten to overcome the double patenting rejections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.” A terminal disclaimer is submitted to overcome the double patenting objection and claim 7 is rewritten in the form indicated as allowable. Claim 8 depends from claim 7 and is allowable in view of the terminal disclaimer.

**Conclusion**

If the Examiner believes it would help to advance the prosecution, the undersigned agent would welcome the opportunity to discuss the application in a further telephone interview and can be reached at (312) 201-0011.

Respectfully submitted,

Dated this 16<sup>th</sup> day of August, 2005.

A handwritten signature in dark ink, appearing to read "Roger J. French", is written over a horizontal line.

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Amendments to the Drawings

Please replace the drawings on Sheet 3: FIGS. 6 and 7 from the application as filed with the drawings correspondingly labeled in the enclosed Replacement Sheet 3. The amendments to the drawings are shown in enclosed corresponding Annotated Marked-Up Drawing.

ANNOTATED MARKED-UP DRAWING

